

REMARKS

Applicants gratefully thank Examiner Jung for taking the time on August 22, 2005, to discuss the pending rejections and applicants' assertion that Stinson et al. does not teach or suggest "*at least two separate bioabsorbable bodies.*" As discussed, applicants herewith amend the claims to require "*at least two separately implantable bioabsorbable bodies.*" Reconsideration of the rejections set forth in the Final Office Action mailed July 14, 2005, is respectfully requested. Claims 1, 8, 10, 12-15, 18-19, 28-31, 33, 35-36 have been amended. Claim 44 has been newly added. Support for these amendments can be found in the specification at, e.g., paragraph [0064] to paragraph [0070] and Fig. 3A. Therefore, no new matter was added with these amendments. Claims 1-31, 33-36, and 44 remain pending in this application.

Double Patenting

Claims 1-43 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-49 of co-pending Application no. 10/114,712 (Our Ref: 032,290-091) in view of Stinson et al (USP 6,340,367). Applicants respectfully assert that claim 1, as currently amended, is patentably distinct from claims 1-49 of the '712 application in view of Stinson et al. In particular, as discussed more fully in the following section, neither claims 1-49 of the '712 application, nor Stinson et al. teach or suggest a subcutaneous cavity marking device comprising "*at least two separately insertable bioabsorbable bodies.*" Therefore, applicants respectfully request withdrawal of the rejection and reconsideration of the claims as amended.

Art Rejections

Claims 1-15 and 19-43 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stinson et al. (USP 6,340,367). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stinson et al., and further in view of Roth et al. (USP 5,665,063). Claim 18 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stinson et al., and further in view of Wolff et al. (USP 5,997,468). Applicants have amended claim 1 to require “*at least two separately implantable bioabsorbable bodies.*” As discussed with the examiner, Applicants assert that the cited references do not teach or suggest all of the limitations of the claims as currently amended. Indeed, Stinson describes only a single implantable body, a stent. The examiner, however, takes the position that the two markers on the stent can be considered “implantable bioabsorbable bodies.” Adopting this interpretation, Stinson is ineffective because it has no marker. In any case, in order to clarify the distinction, claim 1 now requires at least two separately implantable bodies. This language clarifies that the “at least two implantable bodies” must be capable of separation. They need not be implanted separately. In fact, the presently claimed invention allows the “at least two separately implantable bodies” to be implanted sequentially, simultaneously, or in any other manner, so long as they are capable of being separated. The device of Stinson is not capable of being separated because, under the Examiner’s interpretation, the “at least two separately implantable bioabsorbable bodies” are bonded to a single stent.

Claim 1 is therefore patentably distinct from the cited art. Claims 2-31 and 33-36 are dependent on claim 1, and are therefore patentably distinct from the cited art for the same reasons.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
O'MELVENY & MYERS LLP

Dated: October 12, 2005

By: Diane K. Wong
Diane K. Wong
Reg. No. 54,550
Attorneys for Applicants

DKW/cp

O'Melveny & Myers LLP
610 Newport Center Drive, 17th Floor
Newport Beach, CA 92660-6429
(949) 760-9600